

REMARKS

The Restriction Requirement indicates that claims 1-55 are pending (e.g., at Disposition of Claims in the Office Action Summary). Applicants respectfully point out that 59 claims were filed in the instant application on September 26, 2001. See, for example, claims 56-59 on page 67 of the specification. Furthermore, claims 2-10, 13-29, 46-55, and 57-59 were canceled upon filing of the instant application, as indicated in the Transmittal mailed with the application on September 26, 2001 (see, e.g., item 3 on page 1 of the Transmittal). Moreover, claims 30, 33, and 35 are canceled, and new claims 60-62 are added, by the instant communication. Therefore, claims 1, 11, 12, 31, 32, 34, 36-45, 56, and 60-62 are now pending.

In response to the Restriction Requirement, Applicants hereby provisionally elect the claims of Group VII (including claims 11, 31, 32, 34, and 36-43) drawn to antibodies which specifically bind to polypeptides of SEQ ID NO:1, compositions comprising the antibodies, and methods of making the antibodies, with traverse. In response to the requirement for election of a sequence, Applicants provisionally elect the antibodies which specifically bind to the species of SEQ ID NO:1, also with traverse. Applicants traverse both requirements on the following grounds:

Claims directed to methods of using the claimed antibodies for detecting a polypeptide of the invention (i.e., claim 44), and for purifying a polypeptide of the invention (i.e., claim 45), could and should be examined together with the product claims from which they depend, per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. Applicants presume these method claims will be rejoined, upon determining allowability of the product claims from which they depend.

It is also submitted that claims 1 and 56, drawn to polypeptides of the invention, could be examined along with the antibody claims without undue burden on the Examiner. A search for prior art

to determine the novelty of the antibodies would substantially overlap with a search of the prior art to determine the novelty of the polypeptides specifically bound by the antibodies.

In addition, Applicants traverse the requirement for election of a sequence as between elements in Markush groups (those elements being, respectively, antibodies which specifically bind to polypeptides of SEQ ID NO:1-2). The Examiner's attention is directed to the Patent Office's own requirements for Markush practice, set forth in the 8th edition of the M.P.E.P. (August, 2001) at § 803.02 regarding restriction requirements in Markush-type claims:

PRACTICE RE MARKUSH-TYPE CLAIMS

If the members of the Markush group are **sufficiently few in number or so closely related** that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), **it is improper for the Office to refuse to examine that which applicants regard as their invention**, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, **unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.**

This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, **the examiner may require a provisional election of a single species** prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry. [emphasis added]

As can be seen from the above, it is clear that the present Restriction/Election Requirement does not meet the Patent Office's own requirements.

It is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. All of the claimed antibodies specifically bind to polypeptides which are prostate growth-associated membrane proteins. In addition, the antibodies of the instant invention share a common utility in, for example, toxicology studies based on expression profiling.

Therefore, it is respectfully submitted that, upon searching and examining antibodies which specifically bind to polypeptides of SEQ ID NO:1, and finding no prior art over which these antibodies can be rejected, the Examiner must extend the search of the Markush-type claim to include the non-elected species.

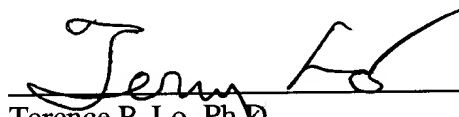
Applicants reserve the right to prosecute non-elected subject matter in subsequent divisional applications.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at (650) 621-8581.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,
INCYTE CORPORATION

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